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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/006,591	12/05/2001	Katherine S. Bowdish	1087-3	3521

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10/15/2004

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EXAMINER

LAMBERTSON, DAVID A

ART UNIT

PAPER NUMBER

1636

DATE MAILED: 10/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

[Handwritten signature]

Advisory Action**Application No.**

10/006,591

Applicant(s)

BOWDISH ET AL.

Examiner

David A. Lambertson

Art Unit

1636

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 04 October 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
- b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: 33-36.

Claim(s) objected to: _____.

Claim(s) rejected: 1-6, 23-32, 37, 73 and 74.

Claim(s) withdrawn from consideration: _____.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____.

Continuation of 5. does NOT place the application in condition for allowance because: the rejections under 35 USC § 102(b) and (e) have not been overcome. Applicant appears to argue that neither Holmes nor Zhu teach the limitation of a "primer sequence being capable of annealing to a first portion of nucleic acid encoding a polypeptide" and a "collar sequence being capable of annealing to a second portion of the nucleic acid encoding the polypeptide." It is set forth that both Zhu and Holmes merely teach that the primer and collar sequences of their plasmids hybridize to "engineered sequences" within a nucleic acid. Applicant appears to argue that the "primer" and "collar" sequences of the instant invention do not anneal to non-coding portions of a nucleic acid (as allegedly set forth in the teachings of Holmes and Zhu), but rather to the coding portions of the nucleic acid. In other words, it appears Applicant is arguing that the term "nucleic acid encoding a polypeptide" is equivalent in scope to the term "polypeptide encoding portion of a nucleic acid." Applicant concludes that because neither Holmes nor Zhu teaches that the "primer" and "collar" sequences of their plasmids hybridize to a polypeptide encoding portion of a nucleic acid, both Holmes and Zhu fail to anticipate the instant invention.

Applicant appears to be improperly interpreting the limitations of the claims more narrowly than the commonly accepted meaning. The term "nucleic acid encoding a polypeptide" is not limited to the coding portion of a nucleic acid (i.e., it is not equivalent in scope to the term "polypeptide encoding portion of a nucleic acid"). Rather the term "nucleic acid encoding a polypeptide" merely means that the nucleic acid encodes a polypeptide somewhere within the sequence. Indeed, a "nucleic acid encoding a polypeptide" frequently contains upstream and downstream sequences such as promoters, enhancers, termination sequences, etc.; this includes primer sequences that are placed at the ends of the sequences because, once those primer sequences have been attached, they become an integral part of the nucleic acid encoding a polypeptide." Thus, it is an indisputable fact that both Zhu and Holmes teach plasmids that have regions of homology (i.e., "primer" and "collar" sequences) to particular nucleic acids, and that the nucleic acids of Holmes and Zhu encode a polypeptide. Thus, the plasmids of Holmes and Zhu teach plasmids containing "primer" and "collar" regions that hybridize to a "nucleic acid that encodes a polypeptide," thereby meeting the disputed limitation of the claims.

Because Applicant has not demonstrated a deficiency in the teachings of Zhu and Holmes as it regards the instantly claimed invention, the claims are still deemed to be anticipated under 35 USC § 102 (b) and (e) as set forth in the previous Office Actions.


JAMES KETTER
PRIMARY EXAMINER